

## **REMARKS**

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

### **I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 1-9 and 11-18 are now pending in this application. The applicants appreciate the acknowledgement of allowable subject matter. Claim 7 has been amended to exclude any overlap with the Hajos reference. As the scope of the claim is narrower than the scope of the claim examined in the previous Office Action and would serve to narrow the issues for Appeal, the amendment should be entered. No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

### **II. THE 35 U.S.C. 112, 2<sup>nd</sup> PARAGRAPH REJECTION HAS BEEN OVERCOME**

Claims 12-14 were rejected as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. The applicants request reconsideration of this rejection for the following reasons.

Claims 12 and 14 have been corrected to amend the dependency on claim 7 instead of claim 1.

### **III. THE 35 U.S.C. 102(b) REJECTION HAS BEEN OVERCOME**

Claims 7, 8, 12 and 13 were rejected as allegedly being anticipated by Hajos et al. (U.S. Patent 4,316,022 - "Hajos"). The applicants request reconsideration of this rejection for the following reasons.

As noted above in the Remarks section above, claim 7 has been amended to remove any overlap with the Hajos reference. A comparison of the Examples in relation to the current claim scope follows below:

Example 1 (excluded by disclaimer v)

Example 2 and intermediate (excluded by disclaimer i)

Example 5 (excluded by disclaimer v)

Example 6 (excluded by disclaimer v)

Example 7 (excluded by disclaimer xiii)

Example 18 (excluded by disclaimer v)

Example 19 (excluded by disclaimer v)

Example 20 (excluded by disclaimer vi)

As all of the applicants claimed elements are not taught by Hajos, the applicants' claims are not anticipated.

#### **IV. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME**

Claims 7, 8, 12 and 13 were rejected as allegedly being obvious by Hajos et al. (U.S. Patent 4,316,022 - "Hajos"). The applicants request reconsideration of this rejection for the following reasons.

As all claimed elements were not described in Hajos as noted above in paragraph IV., the claims are also unobvious over Hajos.

There is no basis for the assertion that any possible differences between Hajos and the applicants' claims as originally presented or in their amended form would have been obvious modifications especially when the compounds of the present invention are directed to herbicidal use, i.e. whatever motivation there would have been to modify the compounds of Hajos would have been in the context of providing analgesic, antiphlogistic or narcosis-potentiating effect.

No direction is given for such modifications, i.e. there would have been an infinite number of possibilities for modification which no reason to select the applicants' particular modifications. In addition, there would have been no expectation of success for the modification which would have been consistent with the expected use of Hajos's compounds, i.e. providing analgesic, antiphlogistic or narcosis-potentiating effect.

Therefore, Hajos does not render the applicants' claimed compounds obvious to one of ordinary skill in the art.

**CONCLUSION AND NOTE FOR EXAMINER**

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited.

**As there was previously an indication of allowable subject matter, please contact the undersigned to discuss a possible Examiner's Amendment if all of the pending claims are not allowed.**

The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP

By: /Howard C. Lee/  
Marilyn M. Brogan     Howard C. Lee  
Reg. No. 31,223     Reg. No. 48,104  
Telephone:     (212) 588-0800  
Facsimile:     (212) 588-0500